

## **REMARKS**

This application has been reviewed in light of the Final Office Action mailed May 17, 2005. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 17-44 are pending in the application with Claims 17, 28, 29 and 36 being in independent form. By the present amendment, Claims 17 and 28 have been amended. No new subject matter or issues have been introduced by way of the present amendment.

Initially, Applicants thank the Examiner for indicating that Claims 29-44 are allowed, and that Claims 21-23 and 25-27 contain subject matter that would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **I. Rejection of Claims 17-19 and 28 Under 35 U.S.C. §102(b)**

Claims 17-19 and 28 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,558,671 issued to Yates.

Yates teaches an impedance feedback monitor for electro-surgical instruments, wherein the impedance of the tissue between a set of poles of an electro-surgical instrument is monitored. Based on modeled tissue impedance behavior from exposure to RF electro-surgical energy over time, the tissue status is determined.

Applicants' Claim 17 recites in part: "...a therapeutic condition estimation circuit that estimates the therapeutic condition based on information of the therapeutic condition monitored during the treatment, the therapeutic condition estimation circuit selecting a target value corresponding to the estimated therapeutic condition upon completion of the treatment among a plurality of predetermined target values, said information being based on dimensions of a contact area between said electrodes and a treatment site..." Claim 28 recites in part: "...estimating the therapeutic condition upon completion of the treatment based on information of the therapeutic

condition monitored during the treatment, said information being based on dimensions of a contact area between said electrodes and a treatment site...” (Emphasis added). The limitations recited in the amended Claims 17 and 28 are supported by FIG. 3 and paragraphs 0073-0075 of the specification, thus no new matter or issues have been introduced by way of the present amendment.

Contrastingly, Yates does not teach varying the electro-surgical energy based on results of the detecting circuit, where the results are based on the dimensions of the contact area between the electrodes and the treatment site. There is no determination of the general dimensions of the established contact area in Yates.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02: “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Therefore, it is not reasonably possible for Yates to anticipate Applicants Invention as recited in Claims 17 and 28, as Yates fails to explicitly teach, or inherently suggest, all the claimed limitations of Applicants’ Claims 17 and 28 arranged as required by the claims.

The remaining rejected claims, namely Claims 18-19, depend from Independent Claim 17 and thus are limited by the limitations recited that independent claim. Therefore, for at least the reasons given above, Claims 18-19 are believed allowable over the cited prior art references.

Therefore, Claims 17-19 and 28 are believed patentably distinct and allowable over Yates. Accordingly, Applicants' respectfully request withdrawal of the rejection with respect to Claims 17-19 and 28 under 35 U.S.C. §102(b) over Yates.

## **II. Rejection of Claims 20 and 24 Under 35 U.S.C. §103(a)**

Claims 20 and 24 are rejected under 35 U.S.C. §103(a) over Yates in view of U.S. Patent No. 6,083,223 issued to Baker. However, Claims 20 and 24 depend from Independent Claim 17 and thus are limited by the limitations recited that independent claim.

Baker discloses a method and apparatus for welding blood vessels or tissues by capturing and stretching the tissue to alter its impedance characteristics prior to application of RF energy. However, Baker fails to overcome the deficiencies of Yates with respect to Claim 17. Namely, Baker fails to disclose varying the electro-surgical energy based on results of the detecting circuit, where the results are based on the dimensions of the contact area between the electrodes and the treatment site.

Baker only discloses delivering RF energy for a duration determined by the surgeon's experience or visual observations of the blood vessel during the welding treatment, and alternately, suggests the use of sensors for monitoring temperature, impedance or some other parameter to determine when RF current should be discontinued. (See: Baker col. 7, lines 17-23). No suggestion is made by Baker to vary the RF current during treatment based on any parameters generally, or determining when to vary the RF current based on the determined dimensions of the contact area between the electrodes and the treatment site.

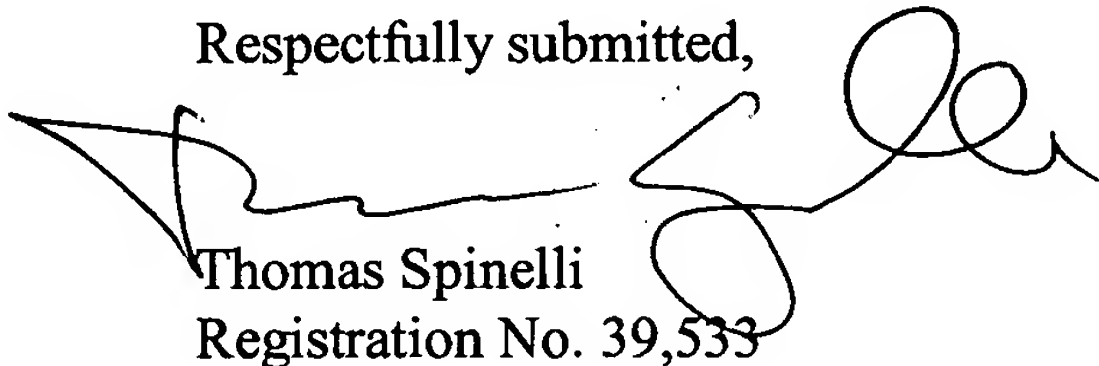
Therefore, Yates and Baker, taken alone or in any proper combination, fail to disclose or suggest Applicants' invention as recited in Claim 17, thus for at least the reason given above, Claims 20 and 24 are believed allowable over the cited prior art references. Accordingly, Applicants' respectfully request withdrawal of the rejection with respect to Claims 20 and 24 under 35 U.S.C. §103(a) over Yates in view of Baker.

## CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 17-44 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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